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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,604	10/30/2003	Rajasekaran Rangarajan	MSFT-2796/306048.1	7874
41505 7590 11/27/2007 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER NGUYEN, VAN H	
			ART UNIT 2194	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,604

Applicant(s)

RANGARAJAN, RAJASEKARAN

Examiner

VAN H. NGUYEN

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the amendment 09/10/2007.

Claims 1-22 are currently pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 USC § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 USC § 112, second paragraph. In *Exparte Lyell*, 17 USPQ 2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 USC § 112, second paragraph.

- As to independent Claim 1: it is unclear whether *a system* or *a process* is claimed.
- As to independent Claim 18: it is unclear whether *a product* or *a process* is claimed.
- Dependent claims 2-10 and 19-22 are rejected for fully incorporating the deficiencies of their base claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter.

The system claim 1 recites a “system” in the preamble only, the body of the claim *merely contains programming steps*. Therefore, the claim is software per se and do not fall within one of the four enumerated categories of patentable subject matter recited in section 101.

Dependent claims 2-10 are rejected for fully incorporating the deficiencies of their base claim.

Under a broadest reasonable interpretation, the method claim 11 is unpatentable under section 101 because (i) it does not qualify as a “process” under section 101, as that term has been interpreted by case law, (ii) it seeks to patent an abstract idea, and (iii) the “useful, concrete, and tangible result” test does not apply here, but the claim nevertheless does not meet that test. The method claim 11 differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the steps, nor does it require any machine or apparatus to perform the steps. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 11 performs *allocating*, *writing*, and *identifying* steps, it does not require any machine or apparatus to perform the steps. Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 11 does not specify whether the entity performing the steps of *allocating*, *writing*, and *identifying* is a computer, a human, or something else. Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claim is “so abstract and sweeping” that it would “wholly pre-empt” all applications (whether performed by a machine or a human) that are directed to identifying to the stub function the function in

the second process to execute by passing information to the stub function. See Benson, 409 U.S. at 68-72, 175 USPQ at 675-677; see also Alappat, 33 F.3d at 1544, 31 USPQ2d at 1558 (quoting Benson).

Dependent claims 11-17 are rejected for fully incorporating the deficiencies of their base claim.

Claims 18-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a signal directly or indirectly by claiming a medium and the Specification recites evidence where the computer-readable medium is defined as a “*wave*” (such as a carrier wave). In that event, the claims are directed to a form of energy which at present the office feels does not fall into a category of invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by **Kessler et al.** (US6157961).

As to claim 11:

Kessler teaches a method for executing a function within a second process from a first process (see the Abstract and col.2, line 55-col.3, line 45), the method comprising:

- allocating space within the second process (see col.5, lines 33-54);
- writing a stub function into the allocated space within the second process (see col.6, line 50-col.7, line 65);
- identifying to the stub function the function in the second process to execute by passing information to the stub function (see col.6, lines 50-67; col.11, line 56-col.12, line 67).

As to claim 12:

Kessler teaches the information passed to the stub function comprises an address in memory within the second process (see col.4, line 56-col.5, line 46).

As to claim 13:

Kessler teaches the function in the second process to be executed by the stub function in the second process is identified by providing a pointer to a location in memory in the

second process at which the function to be executed is stored (see col.3, lines 39-46 and col.4, line 56-col.5, line 46).

As to claim 14:

Kessler teaches at least one parameter required by the function to be executed is identified by providing an offset from the location in memory at which the function to be executed is stored (see col.10, line 3-col.11, line 45).

As to claim 15:

Kessler teaches receiving from the stub function in the second process a result of executing the function identified by the pointer to the location in memory (see col.7, lines 42-55).

As to claim 16:

Kessler teaches the first process controls the second process by executing the stub function (see col.3, lines 1-38).

As to claim 17:

Kessler teaches the stub function is executed by creating a thread in the second process to execute the stub function (see col.5, lines 33-54).

As to claim 18:

The rejection of claim 11 above is incorporated herein in full. Kessler, further teaches passing the stub function a single parameter, the parameter comprising a pointer to an address in memory in the second process (see col.5, lines 1-9).

As to claim 19:

Kessler teaches receiving from the stub function a result of executing the function in the second process (see col.7, lines 42-55).

As to claim 20:

Kessler teaches the function to execute requires a plurality of input parameters (see col.11, line 55-col.12, line 67).

As to claim 21:

Kessler teaches the sub function initializes the plurality of input parameters to values located at specified offsets from the address in memory pointed to by the pointer (see col.10, line 3-col.11, line 45).

As to claim 22:

Kessler teaches the result of executing the function in the second process is stored at a location received from the stub function as a output parameter (see col.11, line 55-col.12, line 67).

As to claim 1

Refer to the discussion of claim 18 above for rejection.

As to claim 2:

Kessler teaches the function controller returns the result of execution of the function to execute to the first process (see col.7, lines 42-55).

As to claim 3:

Kessler teaches the first process controls the second process (see col.3, lines 1-38)..

As to claim 4:

Kessler teaches the function within the second process to execute requires a plurality of parameters (see col.11, line 55-col.12, line 67).

As to claim 5:

Kessler teaches the single parameter passed to the stub function comprises a pointer to a location in memory in the second process (see col.5, lines 1-9).

As to claim 6:

Kessler teaches the location in memory comprises an address, the address comprising the location of the function to execute in the second process (see col.5, lines 1-46).

As to claim 7:

Kessler teaches the address comprises the location of at least one parameter required by the function to execute (see col.5, lines 1-46).

As to claim 8:

Kessler teaches the result of executing the function to execute is returned to the first process (see col.7, lines 42-55).

As to claim 9:

Kessler teaches the result of executing the function to execute is returned to the first process by providing a pointer to the first process, the pointer pointing to stored data, the

stored data comprising the result of executing the function to execute (see col.5, lines 1-46).

As to claim 10:

Kessler teaches the pointer points to memory in the second process (see col.5, lines 1-9).

Response to Arguments

5. Applicant's arguments filed 09/10/2007 have been fully considered but they are not persuasive.

Applicant argued in substance that Kessler does not teach allocating space within the second process. The examiner's response is as follows. Firstly, in the Office Action, the examiner mapped each claimed limitation to relevant passages in the Kessler reference to show how the reference meets the claim limitations. Applicant in response did not provide any underlying analysis as to why the portions of the prior art relied on did not support the examiner's position. Secondly, Kessler teaches allocating space within the second process (see col.5, lines 33-54).

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." In re Hyatt 21 1 F.3d 1367, 1372, 54

USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (1989) "During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process."

Applicant should set forth claims in language that clearly, distinctly, unambiguously, and uniquely define the invention.

Contact Information

6. Any inquiry or a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN H. NGUYEN whose telephone number is (571) 272-3765. The examiner can normally be reached on Monday-Thursday from 8:30AM

6:00PM. The examiner can also be reached on alternative Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM THOMSON can be reached at (571) 272-3718.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



VAN H. NGUYEN
PRIMARY EXAMINER